Supreme Court, U.S.
FILED
JUN 3 2001
OFFICE OF THE CLERK

No. 01-1787

In The
Supreme Court of the United States

SIMPLE TECHNOLOGY, INC.
(now known as SimpleTech),

Petitioner,

v.

DENSE-PAC MICROSYSTEMS, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

This petition involves the same issue recently decided by this Court in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 00-1543 (U.S. May 28, 2002), *vacating and remanding* 234 F.3d 558 (Fed. Cir. 2000) (*en banc*) (hereinafter "*Festo*"), namely whether the amendment of a patent claim during prosecution completely bars the patentee from relying on the doctrine of equivalents as to the amended claim element. Because the sole basis for the judgment below rested upon the complete bar announced in the Federal Circuit's now-vacated opinion in *Festo*, the question presented is whether the judgment below should be vacated and remanded for further proceedings in light of this Court's decision in *Festo*.

CORPORATE DISCLOSURE STATEMENT

Plaintiff Simple Technology, Inc. (now known as SimpleTech, Inc.) ("SimpleTech") has no parent company. No publicly held company owns 10% or more of SimpleTech's stock.

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Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., No. 00-1543 (U.S. May 28, 2002) ..... *passim*

OTHER AUTHORITIES:

28 U.S.C. § 1254 2

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Supreme Court Rule 10(c) 5

PETITION FOR WRIT OF CERTIORARI

Plaintiff SimpleTech respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case. SimpleTech submits that the Federal Circuit's decision should be vacated and remanded in light of this Court's recent decision in *Festo*.

OPINIONS AND ORDERS BELOW

The district court issued four orders relevant to this petition, each of which is unpublished. *See* App. 3-5 (order granting summary judgment of no literal infringement and denying summary judgment of no infringement under the doctrine of equivalents); App. 6-9 (order granting summary judgment under the doctrine of equivalents); App. 10-28 (statement of uncontroverted facts and conclusions of law with respect to the doctrine of equivalents); App. 29-30 (final judgment).

The Court of Appeals for the Federal Circuit affirmed the judgment of the district court in an unpublished order without opinion. *See* App. 1-2.

JURISDICTION

The Federal Circuit's Order affirming the judgment of the district court was entered on March 7, 2002. The Federal Circuit's jurisdiction was based on 28 U.S.C. § 1295(a)(1). The district court's jurisdiction was

based on 28 U.S.C. § 1338(a). This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The United States Constitution provides that "Congress shall have the power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. art. I, § 8, cl. 8.

The Patent Act states that "Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent." 35 U.S.C. § 271(a).

STATEMENT OF THE CASE

The judgment of the district court and of the Federal Circuit in this case are squarely based on the vacated opinion of the Federal Circuit in *Festo*, in which the Federal Circuit held that a narrowing amendment creates a "complete bar" on the application of the doctrine of equivalents for the amended claim element. This Court recently vacated the Federal Circuit's decision in *Festo*, overruling the complete bar rule. Because the judgment below with respect to the doctrine of equivalents was premised solely on the Federal Circuit's vacated *Festo* decision, the present case should also be vacated and remanded.

Petitioner SimpleTech sued respondent Dense-Pac Microsystems, Inc. ("Dense-Pac") for infringement of Claim 12 of U.S. Patent No. Re. 36,916 ("the '916 patent"). The patented technology relates to memory modules used in devices such as computers. Claim 12 of the '916 patent, the only claim at issue, claims an apparatus that vertically stacks two or more memory chips while minimizing the overall profile of the memory module. This multi-chip module includes printed circuit boards, referred to in the patent and Claim 12 as "side boards." These side boards are placed on either side of a vertical stack of two or more memory chips. The side boards serve to conductively connect the memory chips to each other and the underlying circuit board.

During patent prosecution before the Patent and Trademark Office ("PTO"), the PTO Examiner rejected Claim 12, among others, in view of U.S. Patent No. 5,343,075 ("the Nishino patent"), which discloses a pair of L-shaped structures on the sides of stacked devices. App. 14-15. To distinguish the L-shaped structure of the Nishino patent, SimpleTech added the word "planar" before the term "side board." App. 16-19. The Examiner agreed that this amendment would render the claims patentable over the Nishino patent, and ultimately issued U.S. Patent No. 5,514,907, which was subsequently reissued as the '916 patent. App. 19-21.

Dense-Pac makes and sells stacked memory products wherein memory chips are stacked between printed circuit boards. In the accused Dense-Pac products, the printed circuit boards on either side of the stacked memory chips are made of two pieces, whereas the printed circuit boards shown in the '916 patent are made of a single piece. The district court initially granted summary judgment that

Dense-Pac's printed circuit boards were not literally "planar side boards" as recited in Claim 12 of the '916 patent, but denied Dense-Pac's motion for summary judgment that prosecution history estoppel precluded infringement under the doctrine of equivalents. App. 4-6, 12-13.

At the final pretrial conference, Dense-Pac requested leave to file another motion for summary judgment in view of the Federal Circuit's then-recent *Festo* decision. The district court granted Dense-Pac leave, and thereafter granted the new summary judgment motion on the grounds that all equivalents for the "planar side board" claim limitation were completely barred under the Federal Circuit's *Festo* decision. App. 6-9, 24-27. The district court explained its reasoning for granting summary judgment despite its previous ruling that SimpleTech was entitled to a trial on the merits:

> [T]he Court grants defendant's motion for partial summary judgment on the ground that, under *Festo*, plaintiff is completely barred from seeking infringement on the basis of the doctrine of equivalents on account of plaintiff's amendment narrowing the limitation "planar side board."

App. 9. The district court thereafter entered final judgment of no infringement. App. 29-30.

SimpleTech appealed the district court's judgment with respect to both literal infringement and infringement under the doctrine of equivalents to the Court of Appeals for the Federal Circuit. With respect to the doctrine of equivalents, SimpleTech specifically argued that, because the district court's decision on this issue rested solely on the Federal Circuit's *Festo* decision, the case should be remanded to the district court if this Court were to alter

the reasoning of the Federal Circuit's *Festo* decision. On March 7, 2002, the Federal Circuit affirmed the district court's judgment in the instant case without opinion. App. 1-2. On May 28, 2002, this Court altered the Federal Circuit's reasoning in *Festo* by eliminating the complete bar.

REASONS FOR GRANTING THE WRIT

SimpleTech seeks review because this Court's recent opinion in *Festo* eliminated the Federal Circuit's complete bar of the doctrine of equivalents for amended claim elements. *See Festo*, slip op. at 12 ("we disagree with the decision to adopt the complete bar"). This complete bar was the sole basis for the judgment of the district court and the Federal Circuit in the instant case. Accordingly, under Supreme Court Rule 10(c), the decision of the Federal Circuit in this case conflicts with this Court's decision in *Festo*. SimpleTech submits that on remand the evidence will show that SimpleTech's addition of the word "planar" to the asserted Claim 12 of the '916 patent should not bar a finding of equivalence under the guidance this Court outlined in its decision in *Festo*.

As this Court explained in *Festo*, "[t]he Court of Appeals ignored the guidance of *Warner-Jenkinson*, which instructed that courts must be cautious before adopting changes that disrupt settled expectations of the inventing community." *Festo*, slip op. at 14. This case exemplifies the disruption of settled expectations caused by the now-overruled complete bar announced in the Federal Circuit's *Festo* decision. Before the Federal Circuit's *Festo* decision, the district court was prepared to conduct a jury trial on SimpleTech's patent infringement claim based on the

doctrine of equivalents. *See* App. 4, 6, 12-13. Only after the Federal Circuit issued its *Festo* decision did the district court (and the Federal Circuit) determine that SimpleTech's claim should be dismissed as a matter of law. App. 8-9, 24-27. In view of this Court's vacatur of the Federal Circuit's intervening *Festo* decision, SimpleTech should be given the opportunity to establish that it is entitled to its long-awaited trial on its infringement claim under the doctrine of equivalents. Thus, the instant case should be remanded for evaluation in the first instance of the impact of this Court's decision in *Festo* on the availability of equivalents for the "planar side board" claim limitation of SimpleTech's '916 patent.

CONCLUSION

SimpleTech respectfully requests that the Court grant this petition for writ of certiorari, vacate the decision of the Federal Circuit, and remand this case to the Federal Circuit for proceedings consistent with this Court's recent opinion in *Festo*.

Respectfully submitted,

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NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. This disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

01-1310

SIMPLE TECHNOLOGY, INC.
(now known as SimpleTech, Inc.),

Plaintiff-Appellant,

v.

DENSE-PAC MICROSYSTEMS, INC.,

Defendant-Appellee.

JUDGMENT

(Filed March 7, 2002)

ON APPEAL from the UNITED STATES DISTRICT COURT CENTRAL DISTRICT OF CALIFORNIA

In CASE NO(S). 98-CV-822

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (LOURIE, *Circuit Judge*, FRIEDMAN, *Senior Circuit Judge*, CLEVENGER, *Circuit Judge*):

AFFIRMED. *See* Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

DATED MAR -7 2002 /s/ Jan Horbaly/kc
JAN HORBALY, CLERK

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

CIVIL MINUTES – GENERAL

Case No.: SA CV 98-822 AHS (EEx)

Date: February 7, 2001

Title: Simple Technology, Inc. v. Dense-Pac Microsystems, Inc.

PRESENT: **HON. ALICEMARIE H. STOTLER, JUDGE (IN CHAMBERS)**

Debra Beard	Not Present
Deputy Clerk	Court Reporter

ATTORNEYS PRESENT: None

PROCEEDINGS:

RULINGS: (1) DENYING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY OF '916 PATENT; (2) DENYING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF NON-INFRINGEMENT OF '916 PATENT; (3) DENYING PLAINTIFF'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF LITERAL INFRINGEMENT OF CLAIM 12 OF '916 PATENT[1]; (4) GRANTING PLAINTIFF/COUNTER-DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF NON-INFRINGEMENT OF DEFENDANT/COUNTER-CLAIMANT'S '694 PATENT; (5) DENYING DEFENDANT DENSE-PAC

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[1] **Docket Nos. 15, 17, and 26, respectively**, referring to Patent No. 5,154,907, which patent is reissued and now referred to in these proceedings as RE 36,916. See Minute Order of January 2, 2001.

MICROSYSTEM, INC.'S MOTION FOR LEAVE TO FILE SUPPLEMENTAL PAPERS IN OPPOSITION TO PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT OF NON-INFRINGEMENT OF '694 PATENT; (6) DENYING DEFENDANT'S MOTION TO EXCLUDE JOHN REED'S OPINION RE '694 PATENT; (7) DENYING PLAINTIFF'S MOTION TO DISMISS ANY AFFIRMATIVE DEFENSE OR TO AMEND THE COMPLAINT; (8) DENYING PLAINTIFF'S MOTION TO SUPPLEMENT COMPLAINT

Rulings on Enumerated Motions

1. *Defendant's Motion for Summary Judgment of Invalidity of Claim 12 of the '916 Patent*

The Court denies defendant's motion for summary judgment of invalidity of claim 12 of the '916 patent. Defendant fails to establish obviousness of claim 12 of the '916 patent in light of the Sasazawa and/or the Sasazawa/Kira prior art references.

2. *Defendant's Motion for Summary Judgment of Non-Infringement of Claim 12 of the '916 Patent*

The Court denies defendant's motion on non-infringement of claim 12 of the '916 patent. Defendant's M-Densus rail products do not literally infringe claim 12. A finding of literal infringement requires that every single element of a particular claim, or its equivalent, be present in the accused device. The M-Densus products do not employ "planar side boards." Thus, defendant's motion for judgment of non-infringement is denied, except to the extent that it is granted as to literal infringement.

3. *Plaintiff's Motion for Partial Summary Judgment of Literal Infringement of Claim 12 of the '916 Patent*

Plaintiff's motion is denied. See Paragraph 2.

4, 5 and 6. *Plaintiff/Counter-Defendant's Motion for Summary Judgment of Non-Infringement of Defendant/Counter-Claimant's '694 Patent*

A separate Order Granting Plaintiff/Counter-Defendant's Motion for Summary Judgment of Non-Infringement of Defendant/Counter-Claimant's '694 Patent; Denying Defendant's Motion for Leave to File Supplemental Papers Opposing Plaintiff's Motion for Summary Judgment of Non-Infringement of Defendant's '694 Patent; and Denying Defendant's Motion to Exclude John Reed's Opinion re the '694 Patent has been filed and ordered served on all counsel this date.

7 and 8. *Plaintiff's Motion to Dismiss any Affirmative Defense or to Amend the Complaint; and Plaintiff's Motion to Supplement Complaint*

A separate Order Denying Plaintiff's Motion to Dismiss Any Affirmative Defense or to Amend the Complaint; and Denying plaintiff's Motion to Supplement Complaint has been filed and ordered served on all counsel this date.

The Clerk shall serve this minute order on counsel for all parties in this action.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

SIMPLE TECHNOLOGY Plaintiff, v. DENSE-PAC MICRO-SYSTEMS Defendants.	SA CV 98-822 AHS (EEx) MEMORANDUM ORDER GRANTING DEFENDANT'S MOTION FOR PARTIAL SUMMARY JUDGMENT AND ORDER FOR ENTRY OF JUDGMENT (Filed Mar. 29, 2001)

I.

PROCEDURAL BACKGROUND

On February 7, 2001, the Court ruled that plaintiff's Reissue Patent No. 36,916 ('916) was not infringed by defendant because the M-Densus rail products do not employ "planar side boards." The Court denied defendant's motion of non-infringement "except to the extent it is granted as to literal infringement." *See* Feb. 7, 2001 Minute Order. On February 23, 2001, defendant moved for partial summary judgment of non-infringement of claim 12 of the '916 patent in light of the Federal Circuit's decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000). Plaintiff filed opposition on March 9, 2001. Defendant filed a reply on March 16, 2001.

The parties' oral arguments were heard on March 23, 2001, and the motion was taken under submission.

The Court, having considered the papers submitted by the parties, the cases cited therein, and the oral arguments of counsel, grants defendant's motion. Because only Claim 12 is in issue in the complaint, and because all other issues have been adjudicated, the Court orders entry of judgment in favor of defendant.

II.

DISCUSSION

The Court holds that the phrase "planar side boards" should be characterized as a single limitation that has been the subject of amendment. *See Aclara v. Caliper Technologies Corp.*, 125 F.Supp. 2d 391, 402 (N.D. Cal. 2000) ("A limitation . . . is a series of limiting words or phrases that specifically identify the invention in the claims.") (internal quotations omitted); *see also Festo*, 234 F.3d at 563 ("It is preferable to use the term 'limitation' when referring to claim language and the term 'element' when referring to the accused device.").

During the course of this litigation, plaintiff has consistently referred to the phrase "planar side boards" as a single cohesive limitation. *See e.g.*, Malcolm Decl., Ex. O, Pla's Mot. for Partial Summary Judgment of Literal Infringement of Claim 12 of '907 patent at 6:19-24 ("To this point, Dense-Pac has only disputed the interpretation of two claim limitations: (1) "planar side boards" and (2). . . . "); 13:10-15 (" . . . Dense-Pac has argued that its products do not satisfy two limitations of Claim 12. However, Dense-Pac's arguments are based on an erroneous construction of Claim 12 and do not raise any factual issues regarding the structure of its product. A. *The Accused Products Contain Planar Side Boards.*").

Festo holds that any amendment "that narrows the scope of a claim for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element." *See Festo*, 234 F.3d at 564-65. Plaintiff amended its patent application to narrow "first side board" and "second side board" to "first planar side board" and "second planar side board" in response to prior art identified by the examiner. Malcolm Decl., Ex. E-7, 8. The Court finds the amendment to have "narrowed the literal scope of the claim" as contemplated by *Festo* in a prosecution history estoppel analysis. *Id.* at 585.

The court in *Aclara* characterized the consequence of creating prosecution history estoppel as "severe" under *Festo*, *Aclara*, 125 F. Supp. 2d at 391. Whether or not this is so, the Court finds that, in this case, imposition of a complete bar to application of the doctrine of equivalents follows the directive of *Festo*. More recent Federal Circuit decisions point to the same conclusion. *See e.g., Pioneer Magnetics v. Micro Linear Corp.*, 238 F.3d 1341 (Fed. Cir. 2001) (finding "plaintiff [to be] estopped from arguing equivalents to 'switching analog multiplier circuit' limitation of the claims in the '366 patent" where plaintiff had amended claim from "multiplier" to "switching analog multiplier" to avoid prior art which disclosed a power supply containing a non-switching multiplier); *Litton Systems v. Honeywell Inc.*, 238 F.3d 1376, 1380 (finding plaintiff to be "estopped from claiming any equivalents to the 'Kaufman-type ion beam gun' limitation in the disputed claims of the '849 reissue" where plaintiff had "narrowed its claims by amending the term 'ion beam source' to read 'Kaufman-type ion beam source' and the

accused devices did not literally possess a Kaufman-type ion beam gun).

III.

CONCLUSION

Accordingly, and for the foregoing reasons, the Court grants defendant's motion for partial summary judgment on the ground that, under *Festo* plaintiff is completely barred from seeking infringement on the basis of the doctrine of equivalents on account of plaintiff's amendment narrowing the limitation "planar side board." As noted, the Court has previously adjudicated literal infringement adverse to plaintiff.

The Court has this date modified, signed, and filed defendant's proposed Statement of Uncontroverted Facts and Conclusions of Law. The Clerk shall enter judgment for defendant.

IT IS ORDERED.

IT IS FURTHER ORDERED that the Clerk shall serve a copy of this Order on counsel for all parties in this action.

DATED: March 28, 2001.

/s/ Alicemarie H. Stotler
ALICEMARIE H. STOTLER
UNITED STATES DISTRICT JUDGE

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UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

SIMPLE TECHNOLOGY, INC., a California corporation, Plaintiff, vs. DENSE-PAC MICROSYSTEMS, INC., a California corporation, Defendant.	Case No. SACV-98-822 AHS (EEx) **DEFENDANT AND COUNTERCLAIMANT DENSE-PAC MICROSYSTEMS, INC.'S STATEMENT OF UNCONTROVERTED FACTS AND CONCLUSIONS OF LAW IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT OF CLAIM 12 OF UNITED STATES REISSUE**
DENSE-PAC MICROSYSTEMS, INC., a California corporation, Counterclaimant,	

vs.

SIMPLE TECHNOLOGY, INC., a California corporation,

Counterdefendant.

PATENT NO. 36,916 IN LIGHT OF FEDERAL CIRCUIT'S *FESTO* DECISION

TRIAL:

Trial Date: March 27, 2001
Time: 10:00 a.m.
Ctrm: 10A

HEARING:

Hearing Date: March 23, 2001
Time: 3:00 p.m.
Ctrm: 10A

Honorable
Alicemarie H. Stotler

[FILED UNDER SEAL]

(Filed Mar. 29, 2001)

CONFIDENTIAL – ATTORNEYS' EYES ONLY

FILED PURSUANT TO PROTECTIVE ORDER: CONTENTS NOT TO BE REVEALED EXCEPT (1) TO THE COURT AND THEN RESEALED, (2) BY AGREEMENT OF THE PARTIES, OR (3) BY PRIOR ORDER OF THIS COURT

Defendant and counterclaimant Dense-Pac Microsystems, Inc. ("Dense-Pac") submits that the facts set forth herein are uncontroverted for the purposes of its motion for partial summary judgment of non-infringement of claim 12 of United States Reissue No. 36,916 ("the '916 patent"). The '916 patent was substituted into this suit for the surrendered United States Patent No. 5,514,907 by the

Court's order of January 2, 2001. Malcolm Decl., Ex. A at p. 5 [*Minute Order* of Jan. 2, 2001 at p 2].

I. UNCONTROVERTED FACTS

A. Dense-Pac's Rail Design Does Not Literally Infringe Claim 12 of Simple's '916 Patent

1. On May 7, 1999, Plaintiff Simple Technology, Inc. ("Simple") limited the scope of the present litigation to claim 12 of its '916 patent when it unconditionally agreed not to assert any other claims of its patent against Dense-Pac based on any products currently or previously manufactured or sold by Dense-Pac. Malcolm Decl., Ex. B at pp. 7-10 [Plaintiff's Statement of Nonliability as to Claims 1-11 and 13-15 of United States Patent No. 5,514,907 re: Defendant's Motions for Summary Judgment of Invalidity and Noninfringement (filed May 7, 1999)]

2. Simple only alleges infringement as to four Dense-Pac products bearing Dense-Pac part nos. DPSC16MX8RY5, DPSD32MX4RY5, DPSD16MX8RKY5, and DPSD32MR72RW5-PC100. Complaint, ¶ 4. Each of these products uses a "rail" type design. Malcolm Decl., Ex. C at p. 12 [Simple's Statement of Uncontroverted Facts and Conclusions of Law in Support of its Motion for Partial Summary Judgment of Literal Infringement of Claim 12 of '907 Patent at ¶ 1].

3. On February 7, 2001, this Court denied Dense-Pac's motion for summary judgment, but simultaneously held Dense-Pac's rail products do not literally infringe claim 12 of the '916 patent. Malcolm Decl., Ex. D at p. 20 [*Minute Order* (Feb. 7, 2001)] at p. 2.].

4. In granting in part Dense-Pac's motion for summary adjudication of noninfringement, this Court held:

> Defendant's M-Densus rail products do not literally infringe claim 12. A finding of literal infringement requires that every single element of a particular claim, or its equivalent, be present in the accused device. The M-Densus products do not employ "planar side boards." Thus, defendant's motion for summary judgment of noninfringement is denied, except to the extend [sic] that it is granted as to literal infringement.

Malcolm Decl., Ex. D at p. 20 [*Minute Order* (Feb. 7, 2001)] at p. 2.].

B. The Prosecution History of the '916 Patent and Amendment Adding "Planar" to Narrow Scope of Claim 12.

5. When the application that became the '907 patent was initially filed, the Patent Office had already issued patents for stacked semiconductor chips. These prior art patents limit the scope of the claims of the '907 patent. Malcolm Decl., Ex. E [Certified Copy of Prosecution History of U.S. Patent No. 5,514,907]. For example, U.S. Patent No. 5,016,138 issued to Woodman ("Woodman patent"), U.S. Patent No. 5,343,075 issued to Nishino ("Nishino patent"), Japanese Patent No. JP 4-209562 ("Uzuka patent") and Japanese Open Patent Application No. Hei 6-77644 ("Sasazawa reference"), all describe side boards used to construct a stacked semiconductor chip module. Malcolm Decl., Exs. F, G, H, & I.

6. In light of the prior art references, the Patent Office rejected claims 7-15 as being obvious and unpatentable under 35 U.S.C. § 103. Malcolm Decl., Ex. E, p. 97 ['907 File History, Tab 6, p. 4 (Sept. 18, 1995 Office Action)]. In its office action, the examiner explained:

> Claims 7-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Uzuka et al. (JP 4-209562) applicant's submitted prior art.
>
> Uzuka et al. teach a device including first and second side boards 12, 12' with plurality of standard surface mount identical chip(s) 1 stacked between the side boards where each chip of the plurality conductively connected to the (sic) both first and second side boards (pins 15-2 are conductively connected through holes/vias 12-1), and a low pin 3 adjacent to a low (sic) most chip, wherein the lowermost pins serve as leg supports for the whole circuit.

Malcolm Decl., Ex. E, p. 97 ['907 File History, Tab 6, p. 4 (Sept. 18, 1995 Office Action)].

7. On November 3, 1995, the examiner, Jhihan Clark, his supervisor, Dr. Sara Crane, and Simple's patent attorney, William H. Shreve, had an interview regarding patentability of claim 7. Malcolm Decl., Ex. E, p. 100 ['907 File History, Tab 7, p. 2 (Nov. 11, 1995 Examiner Interview Summary Record)].[1] Indeed, the Examiner Interview

---

[1] Claim 12 was initially a dependent claim dependent on independent claim 7. Malcolm Decl., Ex. J [U.S. Patent No. 5,514,907]. During the reissue process, claim 7 was canceled, and Claim 12 was rewritten as an independent claim incorporating all of claim 7's language and elements. Malcolm Decl., Ex. K [U.S. Patent No. Re. 36,916].

Summary Record indicates that the only issue discussed was claim 7. Malcolm Decl., Ex. E, p. 100 ('907 File History, Tab 7, p. 1 (Nov. 11, 1995 Examiner Interview Summary Record)). The examiner described the nature of the conversation as follows:

> We discussed definitions of claim terms "planar" and "pads." We also discussed language to further define pin geometry on the chips. Applicant will submit an amendment. Claim language as attached would define over the 3 references above.

Malcolm Decl., Ex. E, p. 100 ('907 File History, Tab 7, p. 2 (Nov. 11, 1995 Examiner Interview Summary Record)).

8. The three prior art references were JP 4-209562 (the "Uzuka, et al patent"), JP 61-63048 (the "Kageyama patent") and U.S. Patent No. 5,343,075 (the "Nishino patent"). Malcolm Decl., Ex. E, p. 100 ('907 File History, Tab 7, p. 2 (Nov. 11, 1995 Examiner Interview Summary Record)).

9. Simple provided a proposed claim amendment adding "planar" to modify side boards, which is attached to the Examiner Interview Summary Record, and reads as follows (underlined words represent words being added; *italicized* words represent handwritten notes indicating language that examiner recommended also be added):

> 7. (Twice Amended) A module that includes at least one multi-chip module, said module comprising:
>
> a circuit board having at least first and second sets of surface mount pads;

> a first planar side board including a plurality of surface mount pads positioned along its bottom edge, said plurality of surface mount pads of said, first side board being surface-mounted to said first set of surface mount pads such that said first side board is substantially perpendicular to said circuit board;
>
> a second planar side board including a plurality of surface mount pads positioned along its bottom edge, said plurality of surface mount pads of said second side board being surface-mounted to said second set of surface mount pads such that said second side board is substantially perpendicular to said circuit board and substantially parallel to said first side board; and
>
> a plurality of standard surface mount chips *having a plurality of pins, a portion of each pin extending below a bottom surface of the corresponding chip* stacked between said side boards, each chip of said plurality conductively connected to said first side board and said second side board.

Malcolm Decl., Ex. E, p. 101 ['907 File History, Tab 7, p. 3 (Nov. 11, 1995 Examiner Interview Summary Record)]. The examiner's handwritten notes in the margin of the suggested amendment states that Simple "will define in remarks" the circled terms "planar" and "pads."

10. On December 21, 1995, Simple filed an amendment to claim 7 inserting "planar" to modify side boards as well as some of amendments not relevant here. The amendment submitted by Simple reads as follows (underlined words represent added language):

7. (Twice Amended) A module that includes at least one multi-chip module, said module comprising:

a circuit board having at least first and second sets of surface mount pads;

a first planar side board including a plurality of surface mount contacts positioned along an edge of said side first board which abuts said circuit board, said plurality of surface mount contacts of said, first side board being surface-mounted to said first set of surface mount pads of said circuit board such that said first side board is substantially perpendicular to said circuit board;

a second planar side board including a plurality of surface mount contacts positioned along an edge of said second side board which abuts said circuit board, said plurality of surface mount contacts of said second side board being surface-mounted to said second set of surface mount pads of said circuit board such that said second side board is substantially perpendicular to said circuit board and substantially parallel to said first side board; and

a plurality of standard surface mount chips stacked between said side boards, each chip including a plurality of each pin extending beyond a chip surface which lies generally parallel to said circuit board with said chip positioned between said side boards, each chip of said plurality conductively connected to said first side board and said second side board.

Malcolm Decl., Ex. E, p. 102-103 ['907 File History, Tab 8, pp. 1-2 (Applicant's Response to Office Action dated Dec. 6, 1995)].

11. In the Remarks section of the response, applicant explained that these amendments were responsive to the prior art rejection. *Id.* at pp. 104-105 (section entitled "Response to Prior Art Rejection" at p. 3-4). Thus, in light of and responsive to the obviousness rejection, Simple stated:

> Applicant also has more particularly pointed out and distinctly claimed the recited module by claiming the planar nature of the side boards. By "planar," Applicant means a flat plate which has generally uniform rectangular cross-section. . . .
>
> . . .
>
> The examiner also indicated that the proposed amendments to claim 7 would further distinguish the Uzuka, Kageyama, and Nishino patents. Applicant therefore respectfully requests the Examiner to reconsider the rejection of claim 7 in view of the amendments which define further several noval elements of the multi-chip module, and to withdraw the rejection.

Malcolm Decl., Ex. E, p. 107-108 ['907 File History, Tab 8, pp. 6 & 7 (Applicant's Response to Office Action dated Dec. 6, 1995)].

12. Simple explained that the use of planar side boards was a patentable, nonobvious improvement over the prior art because such a design

> "reduces the costs of the module. . . . The planar side boards also are cut from conventional cladding. No special fabrication process (e.g., milling,

> molding or assembling) is required to alter the generally uniform thickness of the planar side board. Fabrication costs are thus reduced over prior designs, such as that illustrated in the Nishino patent."

Malcolm Decl., Ex. E, p. 105-106 ('907 File History, Tab 8, p. 4-5 (Applicant's Response to Office Action dated Dec. 6, 1995)).

13. Indeed, Simple continues to assert that the addition of the term "planar" was to overcome the Nichino patent. In its opposition to Dense-Pac's initial motion for summary adjudication of non-infringement, Simple stated:

> The amendment made to Claim 12 was the addition of the term "planar." [citation omitted] This amendment was made to distinguish the Nishino patent which disclosed a pair of support plates that were fashioned in an "L"-shaped design.

Malcolm Decl., Ex. L at p. 236 [Simple's Opposition to Dense-Pac's Motion for Summary Adjudication of Non-infringement of Claims 1-15 of United States patent No. 5,514,907 p. 24 (filed April 26, 1999)].

14. On January 5, 1996, the Patent Office issued a Notice of Allowability indicating that the amendments, in the examiner's view, overcame the prior art references. Malcolm Decl., Ex. E, p. 112 ['907 File History, Tab 9, p.1 (Notice of Allowability)].

15. On May 7, 1996, the PTO issued U.S. Patent No. 5,514,907. Malcolm Decl., Ex. J [U.S. Patent No. 5,514,907].

16. Claim 12 of the '907 patent – the only claim still at issue in the present suit – reads as follows:

> A module as defined in claim 7, wherein a lowermost chip of said plurality is soldered to said first and second sets of surface mounts.

Malcolm Decl., Ex. J at p. 192 [U.S. Patent No. 5,514,907 at col. 8, lns. 39-41.].

17. On April 22, 1998, Simple filed for a reissue of the '907 patent in which it added 28 new claims and canceled claim 7. Claim 12 was re-written to include all of the language originally contained in claim 7. Claim 12 in the '916 patent reads as follows (language in brackets [ ] being omitted and language in italics being added):

> 12. A module [as defined in claim 7] *that includes at least one multi-chip module, said module comprising:*
>
> *a circuit board having at least first and second sets of surface mount pads;*
>
> *a first planar side board including a plurality of surface mount contacts positioned along an edge of said side first board which abuts said circuit board, said plurality of surface mount contacts of said, first side board being surface-mounted to said first set of surface mount pads of said circuit board such that said first side board is substantially perpendicular to said circuit board;*
>
> *a second planar side board including a plurality of surface mount contacts positioned along an edge of said second side board which abuts said circuit board, said plurality of surface mount contacts of said second side board being surface-mounted to said second set of surface mount pads of said circuit board such that said second side board is substantially perpendicular*

to said circuit board and substantially parallel to said first side board; and

a plurality of standard surface mount chips stacked between said side boards, each chip including a plurality of each pin extending beyond a chip surface which lies generally parallel to said circuit board with said chip positioned between said side boards, each chip of said plurality conductively connected to said first side board and said second side board.

wherein a lower-most chip of said plurality is soldered to said first and second sets of surface mounts.

Malcolm Decl., Ex. K at p. 206 [United States Patent Re. 36,916 (issued October 17, 2000) at col. 8, lns. 2858 (emphasis added)].

II. CONCLUSIONS OF LAW

A. Summary Judgment in Patent Cases

1. Summary judgment is proper when "there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c); *see Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S.Ct. 2548, 2552, 91 L.Ed.2d 265 (1986).

2. "Summary judgment is as appropriate in a patent case as it is in any other case." *Desper Products, Inc. v. OSound Labs, Inc.*, 157 F.3d 1325, 1332 (Fed. Cir. 1998); *see C.R. Bard, Inc. v. Advanced Cardiovascular, Inc.*, 911 F.2d 670, 672 (Fed. Cir. 1990).

B. Doctrine of Equivalents

3. Patent infringement may be found either literally or under the doctrine of equivalents. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997).

4. The doctrine of equivalents prevents an accused infringer from avoiding liability for infringement by changing only minor or insubstantial details of a claimed invention while retaining the invention's essential identity. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608, 70 S.Ct. 854, 94 L.Ed. 1097 (1950); *Warner-Jenkinson Co.*, 520 U.S. at 25-27, 117 S.Ct. at 1045, 137 L.Ed.2d 146.

5. Analysis under the doctrine of equivalents requires an element-by-element correspondence between the accused product and the claimed invention. *Warner-Jenkinson*, 520 U.S. at 29, 40.

6. The doctrine of equivalents is utilized "'[t]o temper unsparing logic and prevent an infringer from stealing the benefit of the invention.'" *Graver Tank*, (quoting *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F.2d 691, 692, 77 U.S.P.Q. 517, 518 (2d Cir.1948) (Hand, J.)).

7. In pursuing these goals, the doctrine attempts to strike a balance between ensuring that the patentee enjoys the full benefit of his patent and ensuring that the claims give "fair notice" of the patent's scope. *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538, 20 U.S.P.Q.2d 1456, 1458-59 (Fed. Cir.1991).

8. This balance can be easily upset, however, because "the doctrine of equivalents, when applied broadly,

conflicts with the definitional and public-notice functions of the statutory claiming requirement." *Warner-Jenkinson*, 520 U.S. at 29, 117 S.Ct. 1040.

C. Prosecution History Estoppel

9. Prosecution history estoppel is one tool that prevents the doctrine of equivalents from vitiating the notice function of claims. *Charles Greiner & Co. v. Mari-Med Mfg., Inc.*, 962 F.2d 1031, 1036, 22 U.S.P.Q.2d 1526, 1529-30 (Fed.Cir.1992).

10. Actions by the patentee, including claim amendments and arguments made before the Patent Office, may give rise to prosecution history estoppel. *Pharmacia & Upjohn Co. v. Mylan Pharms., Inc.*, 170 F.3d 1373, 1376-77, 50 U.S.P.Q.2d 1033, 1036 (Fed.Cir.1999).

11. "Prosecution history estoppel precludes a patentee from obtaining under the doctrine of equivalents coverage of subject matter that has been relinquished during the prosecution of its patent application." *Id.* at 1376, 50 U.S.P.Q.2d at 1036.

12. The logic of prosecution history estoppel is that the patentee, during prosecution, has created a record that fairly notifies the public that the patentee has surrendered the right to claim particular matter as within the reach of the patent. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 564-565, 56 U.S.P.Q.2d 1865 (Fed. Cir. 2000) (*en banc*).

13. The application and scope of prosecution history estoppel is a legal question for the court to determine. *Desper Products*, 157 F.3d at 1338 (citing *Labounty Mfg.*,

Inc. v. United States Int'l Trade Comm'n, 867 F.2d 1572, 1576 (Fed. Cir. 1989)).

D. The Federal Circuit's *en banc* Decision in *Festo Corp. v. Shoketsu Kinsoku Kogyo Kabushiki Co., Ltd.*

1. No Range of Equivalents Given to Amended Claim Element

14. "When a claim amendment creates prosecution history estoppel with regard to a claim element, there is no range of equivalents available for the amended claim element. Application of the doctrine of equivalents to the claim element is completely barred (a "complete bar")." *Festo Corp.*, 234 F.3d at 569.

2. The *Festo* Procedure

15. Finding that prosecution history estoppel creates a "complete bar" to the doctrine of equivalents, the Federal Circuit set forth a straightforward procedure for determining whether prosecution history estoppel applies.

> The first step in a prosecution history estoppel analysis is to determine which claim elements are alleged to be met by equivalents. Then, the court must determine whether the elements at issue were amended during prosecution of the patent. . . . If the claim elements at issue were amended, the court first must determine whether the amendment narrowed the literal scope of the claim. If so, prosecution history estoppel will apply unless the patent holder establishes that the amendment was made for a purpose unrelated to patentability. If the patent holder fails to do so, prosecution history estoppel

> will bar the application of the doctrine of equivalents to that claim element.

Id. at 586.

3. Narrowing Amendments Trigger Prosecution History Estoppel

16. "For the purposes of determining whether an amendment give rise to prosecution history estoppel, a 'substantial reason related to patentability' is not limited to overcoming or avoiding prior art, but instead includes any reason which relates to the statutory requirements for a patent." *Id.* at 566.

17. "Therefore, a narrowing amendment made for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element." *Id.*

[E. 20. lined out by judge /s/ AHS]

F. Retroactive Application of *Festo*

21. The holding in *Festo* applies retroactively to all extant claims amended for patentability purposes. *See Pioneer Magnetics, Inc. v. Micro Linear Corp.*, ___ F.3d ___, 2001 U.S. App. LEXIS 846 (Fed. Cir. Jan. 23, 2001); *Litton Systems, Inc. v. Honeywell Corp.*, ___ F.3d ___, 2001 U.S. App. LEXIS 1529 (Fed. Cir. Feb. 5, 2001); and *Biovail Corp. Int'l v. Andrx Pharms., Inc.*, ___ F.3d ___, 2001 U.S. App. LEXIS 2092 (Fed. Cir. Feb. 13, 2001).

G. Conclusions Of Law In This Case

22. The element at issue for the purposes of this motion is the "planar side boards" of claim 12. The Court has ruled as a matter of law that Dense-Pac's rail products do not literally infringe Simple's '916 patent because they do not employ "planar side boards." Malcolm Decl., Ex. D at p. 20 [Minute Order of February 7, 2001 at p. 2].

23. On December 6, 1995, Simple amended claim 7 (upon which claim 12 was dependent) inserting the adjective "planar" to specify and limit its "side boards." Malcolm Decl., Ex. E, p. 103 ['907 File History, tab 8, p.2 (Applicant's Response to Office Action dated Dec. 6, 1995)].

24. Simple modified claim 7 to narrow the meaning of "side boards" in order to overcome a prior art rejection. Malcolm Decl., Ex. E, p. 103, 107 & 108 ['907 File History, Tab 8, p. 2, 6 & 7 (Applicant's Response to Office Action dated Dec. 6, 1995)].

25. Specifically, Simple narrowed its claim to include only side boards of a planar nature in order to avoid the Uzuka and Nishino prior art references. Simple has admitted as much stating:

> The amendment made to Claim 12 was the addition of the term "planar." [citation omitted] This amendment was made to distinguish the Nishino patent which disclosed a pair of support plates that were fashioned in an "L"-shaped design.

Malcolm Decl., Ex. L at p. 236 [Simple's Opposition to Dense-Pac's Motion for Summary Adjudication of Non-infringement of Claims 1-15 of United States Patent No. 5,514,907 at p. 24 (filed April 26, 1999)].

26. The amendment was made for a "substantial reason related to patentability" – namely to overcome an obviousness rejection under 35 U.S.C. § 103. *Festo Corp.*, 234 F.3d at 566 & 568.

27. Prosecution history estoppel applied and, therefore, completely bars the application of the doctrine of equivalents as to the claim element "planar side boards." *Id.* at 569.

28. Because Dense-Pac's rail products do not literally infringe claim 12's "planar side board" element as a matter of law, Malcolm, Decl., Ex. D at p. 20, and because this element is not permitted any equivalency under the doctrine of equivalents, *Festo Corp.*, 234 F.3d at 569, Dense-Pac cannot as a matter of law be found to have infringed the '916 patent.

29. All of Simple's allegations of literal infringement and infringement by equivalents have been ~~extinguished~~, [adjudicated on the one hand and barred as a matter of law on the other, /s/ AHS] partial summary judgment should be entered against Plaintiff Simple and for the Defendant Dense-Pac on claims of infringement of [claim 12 of /s/ AHS] the '916 patent.

Dated: February 23, 2001

Respectfully submitted,

JONES, DAY, REAVIS & POGUE

By: /s/ Thomas R. Malcolm
Thomas R. Malcolm
Attorneys for Defendant
DENSE-PAC MICRO-SYSTEMS, INC.

IT IS SO ORDERED
DATED March 28, 2001.
/s/ Alicemarie H. Stotler
U.S. District Judge

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

SIMPLE TECHNOLOGY, INC., Plaintiff, v. DENSE-PAC MICROSYSTEMS, INC., Defendant.	) SA CV 98-822 AHS (EEx))))) JUDGMENT)))) (Filed Mar. 29 2001)))

The Court, having denied Defendant's Motion for Summary Judgment of Non-Infringement of United States Patent No. Re. 36,916 ("'916 patent"), having granted, in part, that motion as to literal infringement, having denied Defendant's Motion for Summary Judgment as to Invalidity of Plaintiff's '916 patent, having denied Plaintiff's Motion for Summary Judgment as to Infringement of Claim 12 of the '916 patent, having granted Plaintiff's Motion for Summary Judgment as to Non-infringement of Defendant's '694 patent, and having granted Defendant's Motion for Partial Summary Judgment of Non-Infringement of Claim 12 of the '916 patent, these matters having come before the Court, the Honorable Alicemarie H. Stotler, District Judge, presiding, and the evidence presented having been fully considered, the issues having been duly considered, and decisions thereon having been duly rendered,

IT IS ORDERED AND ADJUDGED:

that plaintiff take nothing on its complaint, that defendant take nothing on its counter-claim, and that defendant shall, as the prevailing party, recover its costs of suit.

DATED: March 28, 2001.

/s/ Alicemarie H. Stotler
ALICEMARIE H. STOTLER
UNITED STATES DISTRICT JUDGE

Supreme Court, U.S.
FILED
JUL 8 2002
OFFICE OF THE CLERK

(2)

No. 01-1787

IN THE

Supreme Court of the United States

SIMPLE TECHNOLOGY, INC.,

Petitioner,

v.

DENSE-PAC MICROSYSTEMS, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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RP55

QUESTIONS PRESENTED

Whether a grant of certiorari, vacatur, and remand in light of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. __ (May 28, 2002) is appropriate in the circumstances of this case, where petitioner waived its claim of infringement under the doctrine of equivalents, clearly and unequivocally, before the United States Court of Appeals for the Federal Circuit.

CORPORATE DISCLOSURE STATEMENT

Respondent Dense-Pac Microsystems, Inc., now known as DPAC Technologies Corp., is a publicly traded corporation. No parent or publicly held company owns 10% or more of its stock.

RESPONDENT'S BRIEF IN OPPOSITION

The petition for certiorari should be denied. Petitioner clearly and unequivocally waived its claim of infringement under the doctrine of equivalents in oral argument before the Court of Appeals. Petitioner's strategic waiver of this aspect of its infringement claim induced the Court of Appeals to decide this case without reaching either of the two doctrine-of-equivalents-related arguments offered by Dense-Pac in support of affirmance. The *Festo* issue on which petitioner now seeks review was only one of those two arguments; had petitioner not expressly waived reliance on the doctrine of equivalents, the Court of Appeals might well have grounded affirmance upon the non-*Festo* ground.

But because the Court of Appeals' decision was unquestionably based on petitioner's waiver, there is no reasonable probability that the decision below rests upon the Court of Appeals' prior decision in *Festo*, and therefore no possibility that the Federal Circuit's summary affirmance would in any way be altered in light of this Court's decision in *Festo*.

STATEMENT OF THE CASE

1. Petitioner SimpleTech ("Simple") is the owner of U.S. Patent No. Re. 36,916 ("the '916 patent"), entitled "Apparatus for Stacking Semiconductor Chips." The '916 patent is a reissue of Simple's U.S. Patent No. 5,514,907 ("the '907 patent"). During prosecution of the application that led to the '907 patent, the Patent and Trademark Office examiner rejected claims 7-15 of that application as obvious under 35 U.S.C. § 103. Pet. App. 14. In response, Simple amended those claims to overcome this obviousness rejection by narrowing the original claims' requirement of a "side board" to require a "*planar* side board." The '907 patent issued to Simple on May 7, 1996. Simple then filed a reissue application on April 22, 1998, and eventually obtained a reissue of the '907 patent — the '916 patent — on October 17, 2000. Pet. App. 20-21.

2. On September 28, 1998, petitioner sued respondent Dense-Pac Microsystems, Inc. ("Dense-Pac") for infringe-

ment of one of those narrowed claims, claim 12 of the '907 patent; once the PTO granted Simple's reissue application, claim 12 of the '916 patent (which did not alter the substance of claim 12) was substituted into the case in place of claim 12 of the '907 patent.

3. In April and May 1999, Simple and Dense-Pac filed cross-motions for summary judgment on infringement and other issues. Dense-Pac urged that it was entitled to summary judgment because, as properly construed, claim 12 did not literally cover Dense-Pac's accused products. C.A. App. A-116. With respect to infringement under the doctrine of equivalents, Dense-Pac urged that it was entitled to summary judgment because its accused products "do not have any equivalent structure to the structure required by the claim limitations," and because "both prosecution history estoppel and the scope and content of the prior art bar Simple from asserting [equivalence]." C.A. App. A-121. The district court decided those motions on February 7, 2001. Pet. App. 3. With respect to the infringement issues presented in those motions, the court denied Dense-Pac's motion for summary judgment of noninfringement, "except to the extent that it is granted as to literal infringement." Pet. App. 4. This ruling left only Dense-Pac's infringement-by-equivalents claim in the case.

4. Because the Federal Circuit had issued its *en banc* decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000), after the parties' dispositive motions were filed, but before the district court's ruling, Dense-Pac brought a second summary-judgment motion which urged that Simple was barred from asserting its equivalents claim on the ground of prosecution-history estoppel under *Festo*. Pet. App. 6. The district court granted Dense-Pac's motion, holding that "under *Festo* [Simple] is completely barred from seeking infringement on the basis of the doctrine of equivalents on account of [Simple's] amendment narrowing the limitation." Pet. App. 9.

5. Simple appealed to the Court of Appeals for the Federal Circuit. Simple argued, *inter alia*, that the district

court had erred in denying its motion for summary judgment of literal infringement, and in granting Dense-Pac's motions for summary judgment of literal and equivalents noninfringement. Brief of Plaintiff-Appellant in No. 01-1310, *Simple Technology, Inc. v. Dense-Pac Microsystems, Inc.* ("Simple C.A. Br.") at 36, 42. With respect to its equivalents claim, Simple argued that it "does not dispute that under [the Federal Circuit's] decision in *Festo*, equivalents are not available." Simple C.A. Br. at 42. But, Simple's primary submission was that it was simply "unnecessary to resort to the doctrine of equivalents" in this case. Simple C.A. Br. at 42.

Dense-Pac's brief in opposition urged two alternative grounds for affirming the summary judgment of no infringement by equivalents. First, of course, Dense-Pac urged that the district court had correctly applied the Federal Circuit's decision in *Festo*. Brief of Defendant-Appellee in No. 01-1310, *Simple Technology, Inc. v. Dense-Pac Microsystems, Inc.* ("Dense-Pac C.A. Br.") at 36-38. Second, however, Dense-Pac also urged that the judgment of nonequivalence could be affirmed on an independent ground, wholly unrelated to *Festo* — because Simple's claim of infringement by equivalents would have rendered the structural limitations of the claim meaningless. Dense-Pac C.A. Br. at 38-42. As Dense-Pac wrote in its brief: "Even without the complete bar of *Festo,* claim 12 cannot be found to be infringed under the doctrine of equivalents without rend[er]ing meaningless the structural limitations of the claim." Dense-Pac C.A. Br. at 38.

6. On March 6, 2002, two months after this Court had heard argument in *Festo*, a panel of the Court of Appeals for the Federal Circuit (Lourie, Friedman, and Clevenger, JJ.) heard oral argument in this case. (Audiotape copies of the Federal Circuit's recording of this argument have been lodged with the Clerk of this Court.) At oral argument, petitioner's counsel made comments urging the panel that it was unnecessary for it to even reach the doctrine-of-equivalents issues presented in the briefs. In response, the

court asked petitioner's counsel point-blank whether he was waiving any claim under the doctrine of equivalents:

> THE COURT: But for our purposes in deciding the case, I mean there was a claim that you were entitled to equivalents under the doctrine of equivalents. Are you saying to us that you're waiving any claim under the doctrine of equivalents?
>
> Mr. RE: Correct.

Counsel for Simple similarly agreed with the panel's statement, at oral argument, that "[s]o when we write our opinion we can just say that we don't have to reach the question about whether or not *Festo* applies in this case."

The final colloquy between Simple's counsel and the Court of Appeals panel made Simple's waiver of its doctrine-of-equivalents claim absolutely clear:

> THE COURT: You are pitching to us a literal infringement case, period.
>
> Mr. RE: That's correct.
>
> THE COURT: O.K. Right.

7. On March 7, 2002, the day following oral argument, the Court of Appeals issued a summary affirmance pursuant to its Rule 36. Pet. App. 1-2. Simple did not petition the Court of Appeals for rehearing, or rehearing *en banc*.

REASONS FOR DENYING THE PETITION

In *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. __ (May 28, 2002), this Court addressed the conditions under which prosecution-history estoppel bars a patent owner from resorting to the doctrine of equivalents where the patent applicant, during prosecution, narrows a claim limitation in order to obtain the patent. A primary (but not the only) legal limitation on the doctrine of equivalents is the principle of prosecution-history estoppel, which prohibits patent owners from obtaining, through litigation, coverage of subject matter they surrendered during prosecution. But neither the doctrine of equivalents, nor prosecution-history estoppel, nor *Festo*, plays any role

in this case, because petitioner expressly waived its equivalents claim — not just its *Festo*-related argument for reversal, but its entire doctrine-of-equivalents claim — during oral argument in front of the Court of Appeals. As a result of this waiver, the *Festo* issue presented by the petition was not pressed in, or passed upon by, the Court of Appeals, so the petition should be denied.

I. PETITIONER'S WAIVER OF ITS EQUIVALENTS CLAIM BEFORE THE COURT OF APPEALS PREVENTS IT FROM RAISING THE *FESTO* ISSUE BEFORE THIS COURT

Petitioner asks that the Court grant certiorari, vacate the judgment below, and remand ("GVR") in light of this Court's decision in *Festo*. Petitioner argues (Pet. at 5) that the Federal Circuit's decision in *Festo* was the "sole basis" for the judgment of the district court and the Court of Appeals in the present case. But that is untrue: Petitioner expressly waived *any* claim for relief under the doctrine of equivalents, and that waiver obviated any relevance that this Court's decision in *Festo* might have had to the Court of Appeals' decision.

During oral argument below, counsel for petitioner conceded that "the *Festo* issue I don't think is relevant at all" to the Court of Appeals' decision in the case. Petitioner's counsel, as well as the Court of Appeals, was certainly aware of this Court's pending decision in *Festo* and of the possibility that the Federal Circuit's prior ruling might be altered by this Court. That is why the panel asked petitioner's counsel if "you're saying to us that you're waiving any claim under the doctrine of equivalents?", to which petitioner's counsel responded with a clear and unequivocal "correct." The "complete bar" of the Federal Circuit's *Festo* decision was therefore not the "sole basis" for the Court of Appeals' decision here; indeed, Simple's waiver eliminated any controversy between the parties as to the doctrine of equivalents. Simple's clear and unequivocal waiver of its equivalents claim was necessarily the "sole basis" for the court's rejection of that claim.

Given petitioner's waiver, there is no basis for certiorari here. This Court denies certiorari when the question presented was "not pressed or passed upon below." *Duignan v. United States*, 274 U.S. 195, 200 (1927); *see also Izumi Seimitsu Kogyo Kabushiki Kaisha v. U.S. Philips Corp.*, 510 U.S. 27, 38 n.7 (1993) (per curiam). Here, Simple's waiver of its equivalents claim necessarily means that the *Festo*/prosecution-history-estoppel issue for which it now seeks GVR relief was neither "pressed" by Simple, nor was it "passed upon" by the Court of Appeals below. Under these circumstances, petitioner is precluded from now seeking to resurrect the *Festo* issue before this Court. *See, e.g., United States v. Ortiz*, 422 U.S. 891, 898 (1975) (declining to consider an argument which was not raised below and which was contrary to petitioner's representations to the Court of Appeals).

II. A GVR ORDER IS NOT APPROPRIATE IN VIEW OF PETITIONER'S WAIVER, SINCE THERE IS NO REASONABLE PROBABILITY THAT THE LOWER COURT'S DECISION WOULD BE DIFFERENT IN LIGHT OF THIS COURT'S DECISION IN *FESTO*

Petitioner urges (Pet. at 5) that GVR is appropriate here because the decision below "exemplifies the disruption of settled expectations caused by the now-overruled complete bar announced in [*Festo*]." If anything, it is petitioner's attempt to resurrect its waived infringement-by-equivalents claim that disrupts respondent's, and the courts', "settled expectations" in finality and repose.

As this Court has held, a GVR order is only appropriate where

> intervening developments, or recent developments that [this Court] ha[s] reason to believe the court below did not fully consider, reveal a reasonable probability that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration, and where it appears that such a

> redetermination may determine the ultimate outcome of the litigation.

Lawrence v. Chater, 516 U.S. 163, 167 (1996). Petitioner must meet each of these three standards to demonstrate its entitlement to GVR relief, but it is clear that it cannot do so.

First, there is no "reason to believe the court below did not fully consider" any issue that is relevant here. As shown above, petitioner's unmistakable waiver of its equivalents claim, and its clear representation to the Court of Appeals that it was "pitching . . . a literal infringement case, period," demonstrates that the court below "fully consider[ed]" and properly rejected the only infringement issue that was pressed before it — Simple's literal infringement claim.

Second, the record here reveals no "reasonable probability that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration." Both Simple and the Court of Appeals were acutely aware of the pendency of *Festo* in this Court, and the possibility that the Federal Circuit's "complete bar" might be altered. Yet, Simple chose to waive its claim of infringement under the doctrine of equivalents for strategic reasons. Under those circumstances, the Court of Appeals would unquestionably hold Simple to its waiver.

Third, it does not in any way "appear[] that such a redetermination may determine the ultimate outcome of the litigation." Quite the contrary: Not only was Simple's waiver of its claim of equivalents infringement sufficient to obviate any effect that this Court's decision in *Festo* might have had on this case; but also, the Court of Appeals' decision to affirm the district court's judgment with a summary "*AFFIRMED. See* Fed. Cir. R. 36" (Pet. App. at 1-2) indicates that there were no issues even worthy of discussion.

Finally, it is worth remembering that whether a GVR order is ultimately appropriate depends "on the equities of the case: If it appears that the intervening development, such as a confession of error in some, but not all, aspects of

the decision below, is part of an unfair or manipulative litigation strategy, or if the delay and further cost entailed in a remand are not justified by the potential benefits of further consideration by the lower court, a GVR order is inappropriate." *Lawrence*, 516 U.S. at 168. Here, petitioner manipulated the Court of Appeals into avoiding the merits of its entire doctrine-of-equivalents claim, which prevented that court from considering the *Festo* issue on its merits, *and* prevented the Court from reaching Dense-Pac's non-*Festo*-based argument for affirming the district court's holding of nonequivalence.

Perhaps petitioner's waiver strategy was to prevent the Court of Appeals from rejecting its equivalents case on a non-*Festo* ground. But that should not matter, because petitioner unquestionably waived that claim — not just its present *Festo* argument, but its entire equivalents claim — in the court below, with full knowledge of the consequences of that waiver. Should petitioner in its reply brief seek to escape the consequence of its strategic decision to waive that claim in the Court of Appeals, that would surely confirm petitioner's "unfair or manipulative litigation strategy." Here, as this Court noted in *Lawrence,* the "delay and further cost entailed in a remand" would be wholly unjustifiable in view of the inequitable goals of the petition. Such gamesmanship should not be countenanced by this Court.

CONCLUSION

For the foregoing reasons, the petition for certiorari should be denied.

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In The
Supreme Court of the United States

SIMPLE TECHNOLOGY, INC.
(now known as SimpleTech),

Petitioner,

v.

DENSE-PAC MICROSYSTEMS, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

REPLY BRIEF

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SUMMARY OF REPLY

Respondent Dense-Pac Microsystems, Inc. ("Dense-Pac") does not dispute that the district court's decision, the only opinion rendered in this case, was premised solely on the Federal Circuit's now-vacated *Festo* decision. Accordingly, Dense-Pac presents no argument that could distinguish the merits of this petition from the nine cases that this Court has already vacated and remanded to the Federal Circuit for further consideration in light of this Court's *Festo* decision.[1]

Dense-Pac's sole argument opposing this petition is that Petitioner ("SimpleTech") waived at oral argument any right to rely on the doctrine of equivalents regardless of this Court's then-pending review of the Federal Circuit's *Festo* decision. *See* Opp. at 4-5. But Dense-Pac blatantly misrepresented the record to make that argument.

First, the record reveals that SimpleTech specifically noted this Court's grant of *certiorari* in the *Festo* case and expressly reserved its right to rely upon any change in the law.

Second, Dense-Pac overlooked the law that excuses any possible waiver where there has been an intervening

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[1] *See, e.g., Pioneer Magnetics, Inc. v. Micro Linear Corp.*, 122 S. Ct. 2322 (2002); *Insituform Techs. v. CAT Contracting, et al.*, 122 S. Ct. 2322 (2002); *Senior Techs., Inc. v. R. F. Techs., Inc.*, 122 S. Ct. 2323 (2002); *Creo Prods., Inc. v. Dainippon Screen, et al.*, 122 S. Ct. 2323 (2002); *Semitool, Inc. v. Novellus Sys., Inc.*, 122 S. Ct. 2323 (2002); Lockheed *Martin Corp. v. Space Systems/Loral, Inc.*, 122 S. Ct. 2349 (2002); *Accuscan, Inc. v. Xerox Corp.*, 122 S. Ct. 2323 (2002); *PTI Techs., Inc. v. Pall Corp. Tech., Inc.*, 122 S. Ct. 2324 (2002); *Mycogen Plant Sci., et al. v. Monsanto Corp.*, 122 S. Ct. 2324 (2002).

change in the law. A wealth of precedent holds there can be no waiver where a change in the law materially alters a party's claim or defense.

Accordingly, this Court should grant this petition, vacate the decision of the Federal Circuit, and remand the case for reconsideration under this Court's recently issued *Festo* decision.

I. SIMPLETECH EXPRESSLY RESERVED ITS RIGHT TO RELY ON THE DOCTRINE OF EQUIVALENTS IN THE EVENT THIS COURT ALTERED THE REASONING OF THE FEDERAL CIRCUIT'S DECISION IN *FESTO*

Dense-Pac's waiver argument relies solely upon a blatant misrepresentation of the record before the Federal Circuit. When fully and accurately quoted, the record shows that SimpleTech did not waive its right to rely on a change in the law relating to *Festo*. To the contrary, SimpleTech repeatedly noted this Court's grant of *certiorari* in *Festo* and expressly argued that the case should be remanded if this Court altered the Federal Circuit's *Festo* decision in any significant way.

The Federal Circuit's *Festo* decision was the controlling law during the entire time this appeal was before the Federal Circuit. Before the grant of *certiorari*, SimpleTech noted in its opening brief that it "does not dispute that under [the Federal Circuit's] decision in *Festo*, equivalents are not available for the 'planar' limitation." SimpleTech C.A. Br. at 42. At this point during the appeal, SimpleTech was addressing Dense-Pac's argument that its products were neither "planar" (added by amendment to patent claims), nor had "sideboards" (present in original patent

claims). Thus, this brief had to acknowledge that the Federal Circuit's *en banc Festo* decision barred any equivalency with regard to the amended portion of the patent claim, *i.e.*, "planar."

After the grant of *certiorari*, Dense-Pac filed its opposition brief in which it did not dispute that its products had "sideboards," thereby narrowing the issue to whether those sideboards were "planar." Because infringement then depended only on whether Dense-Pac's products satisfied the "planar" limitation added by amendment, SimpleTech had to admit that the doctrine of equivalents was not available at all under the Federal Circuit's *Festo* decision.[2] In its reply brief, however, SimpleTech specifically advised the Federal Circuit that, should this Court alter the reasoning in *Festo*, this case should be remanded for further consideration with respect to the doctrine of equivalents. The relevant portion of SimpleTech's reply brief, which Dense-Pac ignored in its opposition to this petition, is set forth below:

> *The parties' dispute regarding the doctrine of equivalents has now been overshadowed by the Supreme Court's grant of certiorari in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 U.S.P.Q.2d 1865 (Fed. Cir. 2000) (*en banc*), *cert. granted*, 121 S. Ct. 2519 (2001).

* * *

[2] *See* Model Code of Prof'l Responsibility DR 7-102 (attorney shall not "knowingly advance a claim or defense that is unwarranted under *existing law*, except that he may advance such claim or defense if it can be supported by good faith argument for an extension, modification, or reversal of existing law.") (emphasis added).

> Although in their principal briefs, Simple Technology and Dense-Pac dispute the scope of equivalents available to "planar side boards" under *Festo*, this issue is now moot because Dense-Pac does not dispute that its rails are literally "side boards." Therefore, literal infringement of the "planar" limitation is determinative of infringement under the doctrine of equivalents. *If, however, the Supreme Court alters the reasoning in Festo, Simple Technology submits this Court should remand the case to the district court for further consideration in light of the Supreme Court's opinion.*

SimpleTech C.A. Reply Br. at 27-28 (emphasis added). In the conclusion of its reply brief, SimpleTech reiterated:

> Alternatively, if the Supreme Court alters this Court's decision in *Festo* in any significant way, this case should be remanded to the district court for further consideration of the doctrine of equivalents consistent with the Supreme Court's decision. *Id.* at 34.

Completely ignoring SimpleTech's reply brief, Dense-Pac bases its waiver argument solely on a discussion that took place during the final minute of oral argument at the Federal Circuit. However, Dense-Pac's selective quotation and creative paraphrasing misrepresents that discussion. Fully transcribed, the relevant portion of the oral argument was as follows:

> COURT: Well for our purposes in deciding the case, I mean there was a claim here that you know, you were entitled to equivalents under the doctrine of equivalents. Are you saying that you are waiving any claim under the doctrine of equivalents?

Mr. Re: Correct. . . . Assu . . . Ah . . . [interrupted]

COURT: Now when we write our opinion we can just say that we don't have to reach the question about whether or not Festo applies to this case.

Mr. Re: *And that assumes, of course, that this Court's applying the current Festo, assuming . . . we did put in our brief the fact that, obviously that issue is still before the United States Supreme Court. Let's assume that this Court's opinion remains intact . . . [interrupted]*

COURT: But you're saying . . . you are pitching to us a literal infringement case period. Right?

Mr. Re: That's correct.

COURT: Okay.

Mr. Re: Thank you.

COURT: Thank you Mr. Re. We will take the case under submission.

Oral Argument, March 7, 2002 (emphasis added).[3]

When asked, SimpleTech conceded that the Federal Circuit's decision in *Festo* foreclosed any application of the doctrine of equivalents in this case, leaving SimpleTech to rely solely upon its literal infringement argument. However, SimpleTech's concession was expressly conditioned on the assumption that the Federal Circuit's *Festo* decision would "remain intact." As SimpleTech's reply brief makes clear, SimpleTech consistently asserted that, if this Court

[3] The tape of the oral argument was lodged with the Court on July 8, 2002.

were to alter the Federal Circuit's *Festo* decision, the Federal Circuit should remand to the district court for further consideration consistent with the decision of this Court.

Thus, contrary to Dense-Pac's argument, SimpleTech did not "strategically" waive any reliance on the doctrine of equivalents.[4] SimpleTech merely admitted, as it was required to do under the Model Code of Professional Responsibility, that controlling law foreclosed its claim under the doctrine of equivalents. SimpleTech could not have advocated a departure from the *en banc Festo* decision to either the district court or to a three-judge panel of the Federal Circuit. Indeed, *after* this Court granted *certiorari*, the Federal Circuit was still repeatedly and consistently applying the absolute bar of its *Festo* decision.[5] Under these circumstances, SimpleTech took all reasonable steps, both in its brief and at oral argument, to preserve the issue in the event this Court altered the Federal Circuit's *Festo* decision.

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[4] Dense-Pac argues that SimpleTech strategically waived its claim under the doctrine of equivalents to ultimately "induce" or "manipulate" the Federal Circuit to forego deciding the equivalency issue on a non-*Festo* ground not relied upon by the district court. Opp. at 1, 8. To suggest that SimpleTech executed such a strategy, solely in response to questions from the panel in the last minute of oral argument, is frivolous. Moreover, Dense-Pac points to no possible benefit to SimpleTech of such a "strategy."

[5] *See, e.g., Pall Corp. v. PTI Techs., Inc.*, 259 F.3d 1383, 1390 (Fed. Cir. 2001), *vacated and remanded*, 122 S. Ct. 2324 (2002); *Glaxo Gp. Ltd. v. Ranbaxy Pharms., Inc.*, 262 F.3d 1333, 1338 (Fed. Cir. 2001); *Ecolab, Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1371 (Fed. Cir. 2001); *Intermatic, Inc. v. Lamson & Sessions Co.*, 273 F.3d 1355, 1366 (Fed. Cir. 2001).

The present scenario is by no means unusual. Under like circumstances, this Court has vacated and remanded other patent appeals to the Federal Circuit for reconsideration in view of this Court's *Festo* decision. *See, e.g., Pall Corp. v. PTI Techs., Inc.*, 259 F.3d 1383 (Fed. Cir. 2001), *vacated and remanded*, 122 S. Ct. 2324 (2002). In *Pall*, the plaintiff admitted that the Federal Circuit's *Festo* decision foreclosed all recourse to the doctrine of equivalents. *See Pall*, 259 F.3d at 1390 ("Both parties now agree that our decision in [*Festo*,] issued after the submission of briefs, forecloses resort to the doctrine of equivalents as to the net supporters limitation."). Accordingly, the Federal Circuit held that the doctrine of equivalents was unavailable. *Id.* Nevertheless, this Court vacated and remanded the case to the Federal Circuit on June 3, 2002. Similarly, SimpleTech's unremarkable concession that it was bound by the Federal Circuit's *Festo* decision cannot constitute a waiver of its claim of infringement under the doctrine of equivalents.

II. EVEN IF THERE WAS A WAIVER, THE CHANGE IN THE LAW ANNOUNCED IN THIS COURT'S *FESTO* DECISION PRESENTS EXCEPTIONAL CIRCUMSTANCES FOR REFUSING TO ENFORCE THE WAIVER

Even if this Court were to find that SimpleTech waived its doctrine of equivalents claim, that waiver should not be enforced because of the change in the controlling law announced by this Court's *Festo* decision. When a decision of this Court has changed the controlling law during litigation, this Court has refused to find a waiver. *See Curtis Publ'g Co. v. Butts*, 388 U.S. 130, 145 (1967) (reversing circuit court finding of waiver in view of this Court's decision in *New York Times Co. v. Sullivan*,

376 U.S. 254 (1964), requiring actual malice to prove defamation of public officials).

Similarly, the Federal Circuit has explained that "[a] circuit court will disregard the rule [of waiver] in compelling circumstances, such as . . . a serious issue of public policy, *a change in the law*, or for error that works manifest injustice."[6] Other circuit courts also routinely recognize an exception to the general rule of waiver "when there has been an intervening change in the law recognizing an issue that was not previously available."[7]

Moreover, this Court has observed "[t]here may always be exceptional cases or particular circumstances which will prompt a reviewing or appellate court, where injustice might otherwise result, to consider questions of law which were neither pressed nor passed upon by the

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[6] *See Interactive Gift Express v. Compuserve, Inc.*, 256 F.3d 1323, 1345 (Fed. Cir. 2001) (quoting 19 Moore's Federal Practice and Procedure § 205.05 at 205-58) (emphasis added); *see also Hughes Aircraft v. United States*, 86 F.3d 1566, 1581-82 (Fed. Cir. 1996) ("[T]he federal courts of appeal have uniformly recognized that an intervening change in applicable law is a strong basis for reconsideration of a decided issue in a pending case.") (Nies, J. dissenting), *vacated and remanded*, 520 U.S. 1183 (1997).

[7] *Holland v. Big River Minerals Corp.*, 181 F.3d 597, 605 (4th Cir. 1999) (*citing Curtis Publ'g*, 388 U.S. at 142-45); *see, e.g., Big Horn County Elec. Coop., Inc. v. Adams*, 219 F.3d 944, 953 (9th Cir. 2000) ("an exception to the waiver rule exists for intervening changes in the law.") (*citing Curtis*); *Holzsager v. Valley Hosp.*, 646 F.2d 792, 796 (2d Cir. 1981) (*citing Curtis*); *Santos v. United States*, 417 F.2d 340, 345 (7th Cir. 1969) ("Defendants should not be required to anticipate favorable Supreme Court rulings or compelled to make the futile gesture of raising the privilege at trial to preserve their rights in the event of . . . [a favorable forthcoming] decision."), *vacated on other grounds*, 397 U.S. 46 (1970).

court . . . below." *Hormel v. Helvering*, 312 U.S. 552, 557 (1941); *see also Grossart v. Dinaso*, 758 F.2d 1221, 1226 (7th Cir. 1985) ("waiver may be overlooked in 'exceptional cases or particular circumstances . . . where injustice might otherwise result.'").

Thus, even if this Court were to find that SimpleTech somehow waived its reliance on the doctrine of equivalents, enforcement of any such waiver should be excused due to the intervening change in the law, or because of the manifest injustice that finding such a waiver would cause. Both in its briefs and at oral argument, SimpleTech merely complied with the ethical requirement that counsel refrain from pressing claims that are foreclosed by existing law. To hold such compliance to be a waiver of the right to rely on an intervening change in the law serves no legitimate purpose, and would be manifestly unjust.

CONCLUSION

Because SimpleTech never waived any claim before the Federal Circuit and because finding such a waiver would cause manifest injustice, this Court should grant the petition, vacate the decision of the Federal Circuit, and remand in light of this Court's recent *Festo* decision.

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